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| 10/824,145 | 04/13/2004 | Masahiro Kisono | 2271/72197 | 6384 |
| 23432 7590 10/23/2007 COOPER & DUNHAM, LLP 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036 | | | EXAMINER ANWARI, MACEEH | |
| | | | ART UNIT 2144 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,145

Applicant(s)

KISONO, MASAHIRO

Examiner

Maceeh Anwari

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All. b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/06/2005, 04/13/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is the initial Office action based on the 10/824145 application filed on 04/13/2004. Claims 1-14, as originally filled, are currently pending and have been considered below.

Claim Objections

2. Claim 5 is objected to because of the following informalities: as stated applicant lacks antecedent basis for *the network terminal apparatus*. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4 & 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant uses the term *predetermined interval(s)* without successfully distinguishing it from any other *interval*; therefore the examiner will interpret it to be the same as any *interval*. Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 & 14 are rejected under 35 U.S.C. 101 because the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within

the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "non-functional descriptive material." Both types of "descriptive material" are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2144

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by

Kayashima et al. (hereinafter Kayashima) U.S. Publication No.: 2003/0055939 A1.

Kayashima teaches:

Claim 1: A network terminal apparatus connected to other network terminal apparatuses via a network, the network terminal apparatus comprising: a storing unit that stores setting information of the network terminal apparatus; an acquiring unit that transmits an acquisition request for acquiring setting information to one of the other network terminal apparatuses, receives the setting information from the one of the other network terminal apparatuses (Figures 2 & 5-8 and Abstract & Par. 53; transmission source, transmission destination and request from network manager); a setting unit that sets the received setting information to the network terminal apparatus and stores the received setting information in the storing unit (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and setting information to target product); and a transmitting unit that, in response to receipt of an acquisition request for the setting information stored in the storing unit from another one of the other network terminal apparatuses, retrieves the setting information from the storing unit, and transmits the retrieved setting information to the other one of the other network terminal apparatuses (Figures 2 & 5-8 and Abstract & Par. 53-54;

transmission source, transmission destination and setting information to target product).

Claim 2: Wherein the acquiring unit transmits an acquisition request for acquiring a designated item of the setting information, and receives the designated item of the setting information (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and request from a network manager).

Claim 3: Wherein the network terminal apparatus acquires the setting information from a setting information management server provided in the network, that manages the setting information of the network terminal apparatuses (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and request from a network manager).

Claim 4: Wherein the network terminal apparatus acquires the setting information from the setting information management server at predetermined intervals (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and integrated management server).

Claim 5: The network terminal apparatus, further comprising: a transforming unit that, if format of the received setting information does not match format of the network terminal apparatus, transforms the received setting information into format-adjusted setting information (Figures 2 & 5-8 and Abstract; edit program, receive setting information file and communication program); wherein the setting unit sets the format-adjusted setting information to the network terminal apparatus and stores the format-adjusted setting information in the storing unit

(Figures 2 & 5-8 and Abstract; edit program, installing and setting information file and communication program).

Claim 6: Wherein the transforming unit transforms the received setting information based on style sheet that defines an attribute of each element of the setting information (Figures 2 & 5-8 and Abstract & Par. 53-54 & 68 & 70; transmission source, transmission destination and request from a network manager and XSL).

Claim 7: A network terminal apparatus, comprising: means for transmitting a request for acquiring setting information to another network terminal apparatus connected via a network (Figures 2 & 5-8 and Abstract & Par. 53; transmission source, transmission destination and request from network manager); means for receiving the setting information from the other requested network terminal apparatus (Figures 2 & 5-8 and Abstract & Par. 53; transmission source, transmission destination and request from network manager); means for setting the received setting information to the network terminal apparatus (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and setting information to target product); means for storing setting information that store the received setting information (Figures 2 & 6-8 and Abstract; saving setting information); means for receiving a request for acquiring setting information from another network terminal apparatus connected via the network (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and setting information to target product); and means for transmitting

the setting information to the other requesting network terminal apparatus

Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and setting information to target product).

Claim 8: Wherein the means for transmitting a request for acquiring setting information transmits a request for acquiring only items designated by a user (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and request from a network manager).

Claim 9: Wherein a setting information management server is provided in the network; and the setting information is acquired from the setting information management server (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and request from a network manager).

Claim 10: Wherein the network terminal apparatus acquires the setting information from the setting information management server at predetermined intervals (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and integrated management server).

Claim 11: Further comprising: means for transforming, if format of the received setting information does not match format of the network terminal apparatus, the received setting information into format-adjusted setting information (Figures 2 & 5-8 and Abstract; edit program); wherein the means for setting the received setting information sets the format-adjusted setting information to the network terminal apparatus (Figures 2 & 5-8 and Abstract; edit program, receive setting information file and communication program); and the means for storing setting

Art Unit: 2144

information stores the format-adjusted setting information therein (Figures 2 & 5-8 and Abstract; edit program, installing and setting information file and communication program).

Claim 12: Wherein the means for transforming the received setting information transforms the received setting information based on style sheet that defines an attribute of each element of the setting information (Figures 2 & 5-8 and Abstract & Par. 68 & 70; XSL).

Regarding **claims 13 & 14** they are substantially the same as **claim 8** and are thus rejected for reasons similar to those in rejecting **claim 8**.

Examiner Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maceeh Anwari whose telephone number is 571-272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2144

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.


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